

REMARKS

The Office Action mailed December 6, 2010 has been reviewed and reconsideration of the above-identified application is respectfully requested in view of the following amendments and remarks.

Claims 1-16 are pending and stand rejected.

Claims 1, 6 and 11 are independent claims.

Claims 1, 6 and 11 have been amended.

Claims 1, 4-6, 9-11 and 14-16 stand rejected under 35 USC 102(e) as being anticipated by Otsuka (USPPA 2003/0170011). Claims 2-3, 7-8 and 12-13 stand rejected under 35 USC 103(a) as being unpatentable over Otsuka in view of Yun (USP no. 7,565,672).

With regard to the rejection of claims 1, 4-6, 9-11 and 14-16 as being anticipated by Otsuka under 35 USC 102(e), applicant respectfully disagrees with, and explicitly traverses, the rejection of the claims.

The Office Action asserts that Otsuka discloses the claims elements of an optical disc playing method (see Abstract), receiving a command, sending a request, the request including at least identification information (fig. 4A-4B and page 3, para. 0025-0031), receiving the related information and playing the part of content in synchronization with the received related information (figures 5-6 and page 4 para. 0034-0037).

However, a review of Otsuka reveals that Otsuka discloses a system for navigating between local and external user agent documents in an optical player that displays a local document obtained from an optical disk, transmits a request for an external document, the request including a pointer to the local document and displays the external document, wherein the external document includes a navigation button; the navigation button having been customized to be associated with the local document pointer.

With reference to Figure 3, Otsuka illustrates a screen including text data and video data (306) and navigation buttons 308. The navigation buttons may be

customized by a content provider authoring an interaction application. (see para. 0023).

With reference to Figure 4A, Otsuka illustrates, a first step of an authentication process that authenticates the user's ability to receive data from the external source (the authentication process may include the identification of the optical disc, see para. 0024), after authentication a first page 418 associated with a local file (local 1. html) is displayed and then a second (next) page 420 associated with an external file (ext1.html) is displayed. Between the display of the local file and the external file, a request of the ext1.html file is made to an external source. In the request is a pointer to the local file (local 1.html). The external source, in response to the request, provides the requested external document and further customizes the navigation "back" button to include the pointer to the local file (local 1.html). (see para. 0026) The external file is displayed (step 420) with the customized "back" button. When the "back" navigation button is depressed, the local 1.html file is again displayed (see para. 0027).

Similar processing is shown in Figures 4B, 5 and 6.

Thus, under the system of Otsuka, local and external files are sequentially displayed and a customized application function refers to a local file pointer so that the local file may be accessed during the playing of an external file. When the local file is accessed the playing of the external file is terminated and the playing of the local file begins. Otsuka further discloses a means or method for playing the local file from a previous point in cases when the external file is accessed prior to the completion of the playing of the local file.

Thus, Otsuka teaches the individual playing of local and external files as separate actions that transition from one screen to a next screen.

Assuming that the local file is comparable to the claimed "content" and the external file is comparable to the claimed "received related information," then Otsuka fails to disclose the element of "playing said part of content in synchronization with the received related information wherein said *synchronization utilizes the received navigation information in coordination with*

navigation information on said optical disc," as Otsuka discloses that the local file and the external file are separately displayed (played).

In addition, even assuming that the local file and the external file include navigation information, Otsuka fails to disclose that the navigation information of the received content (external file) is used in coordination with the navigation information on said optical disc (local file). Rather, because the files are played separately, there is no need for the navigation information of the local files to be used in coordination with the navigation information of the external file.

A claim is anticipated if and only if each and every element is recited in a single prior art reference.

In this case, Otsuka cannot be said to anticipate the subject matter recited in the claims, as Otsuka discloses playing the received content and the content on the disc separately and fails to teach that the **received information is played in synchronization with the content** or the navigation information is used in coordination with the navigation of the external file.

For the amendments made to the claims and for the remarks made herein, applicant submits that each of the aforementioned claims is not anticipated by the cited reference.

Notwithstanding the argument above, applicant has amended the independent claims to more clearly express the invention claimed by simplifying the claim language. More specifically, the independent claims have been amended to remove the term "in synchronization" and "in coordination with" and replace these terms with the term "with." Thus, the claims now recite the element "to play the ***part of the content with the received*** related information." No new matter has been added. Support for the amendment may be found at least on page 7, lines 23-26 ("[i]n the network server 40, clip files of the audio information base 47B contain *audio information to play the optical disc10 in coordination with the video information* contained in clip files 10D of the optical disc10.") and page 8, lines 17-19 ("...*downloading content (step S170) ... and plays in coordination*

with the information originally existing in the optical disc using the received audio (step S180)."). From the description of the invention it would be understood that the ***received information is played with the data on the optical disk*** and the terms "in synchronization" and "in coordination," while technically applicable terms, introduced uncertainty in the subject matter claimed.

Claims 2-3, 7-8 and 12-13 stand rejected under 35 USC 103(a) as being unpatentable over Otsuka in view of Yun.

Applicant respectfully disagrees with and explicitly traverses the rejection of the claims.

Each of the aforementioned claims depends from one of the independent claims, which has been shown to include subject matter not disclosed by Otsuka.

Yun discloses a method of transferring data from one disk to a second disk. Yun is cited for teaching the elements of the content including a play-list and the request including a language selected by the user.

However, Yun fails to disclose the element of "playing said part of content **with** the received related information," as is recited in the claims.

A claimed invention is prima facie obvious when three basic criteria are met. First, there must be some suggestion or motivation, either in the reference themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the teachings therein. Second, there must be a reasonable expectation of success. And, third, the prior art reference or combined references must teach or suggest all the claim limitations. However, the US Supreme Court in KSR v. Teleflex (citation omitted), held that the teaching, suggestion and motivation test (TSM) is merely to be used as a helpful hint in determining obviousness and a bright light application of such a test is adverse to those factors for determining obviousness enumerated in the Graham v. John Deere (i.e., the scope and content of the prior art, the level of ordinary skill in the art, the differences between the claimed invention and the prior art and objective indicia of non-obviousness).

In this case, the combination of the cited references fails to disclose at least one material element recited in the independent claims and thus, the combination of the cited references cannot be said to render obvious the subject matter recited in the aforementioned dependent claims.

For the amendments made to the claims and for the remarks made herein, applicant submits that the reason for the rejection of the claims has been overcome and respectfully requests that the rejections be withdrawn and a Notice of Allowance be issued.

Although the instant Office Action has been made final, applicant submits that the amendments to the claims should be entered into the record as the amendments provide further clarification of the invention claimed and should only require a cursory search by the Examiner.

Applicant denies any statement, position or averment stated in the Office Action that is not specifically addressed by the foregoing. Any rejection and/or points of argument not addressed are moot in view of the presented arguments and no arguments are waived and none of the statements and/or assertions made in the Office Action is conceded.

Applicant makes no statement regarding the patentability of the subject matter recited in the claims prior to this Amendment and has amended the claims solely to facilitate expeditious prosecution of this patent application. Applicant respectfully reserves the right to pursue claims, including the subject matter encompassed by the originally filed claims, as presented prior to this Amendment, and any additional claims in one or more continuing applications during the pendency of the instant application.

In order to advance the prosecution of the matter, applicant respectfully requests that any errors in form that do not alter the substantive nature of the

arguments presented herein be entered into the record to avoid delay of the prosecution of this matter, pursuant to MPEP 714.03.

However, if the Examiner believes that such minor errors in form cannot be entered into the record or that the disposition of any issues arising from this response may be best resolved by a telephone call, then the Examiner is invited to contact applicant's representative at the telephone number listed below to resolve such minor errors or issues.

No fees are believed necessary for filing this amendment.

Respectfully submitted,
Michael E. Belk, Reg.No. 33,357

Date: January 21, 2011

/Carl A. Giordano/
By: Carl A. Giordano
Attorney for Applicant
Registration No. 41,780

Kindly mail all correspondence to:

Michael E. Belk, Esq.
US PHILIPS CORPORATION
P.O. Box 3001
Briarcliff Manor, NY 10510-8001
Phone: (914) 333-9643
Fax: (914) 332-0615